



#14 App Cal Brief
3/29/05

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Peter M. Perthou
Serial No. : 09/752,015
Filed : December 29, 2000
Title : KEY RING

Art Unit : 3627
Examiner : Suzanne Dino Barrett

BOX AF
Hon. Commissioner for Patents
Washington, D.C. 20231

BRIEF FOR APPELLANT

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(1) REAL PARTY IN INTEREST

Peter M. Perthou.

(2) RELATED APPEALS AND INTERFERENCES

None.

(3) STATUS OF CLAIMS

Claims 1, 2, 4, 6, 7, 9 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chen as a primary reference in view of Jung as a secondary reference and Momemmers as a tertiary reference, and claims 3, 5, 8 and 10 stand additionally rejected in view of Sheldon as a quaternary reference.

(4) STATUS OF AMENDMENTS

No amendment was filed subsequent to final rejection.

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(5) SUMMARY OF INVENTION

The invention is a keyring having a key-holding ring, such as 12, a band, such as web 13, a D-ring, such as 11, coupling the band to the key-holding ring. The D-ring has a U-shaped portion, such as legs 11A, 11B and bight 11C, engaging the key-holding ring and a bar, such as 11D, between the ends of the U-shaped portion and engaging the band. The band may be a web of material having ends looped through the D-ring and joined at the ends. There may be a clamp, such as 18, at the ends of the web of material. The web may have portions that are fastened together for most of their length to define an opening accommodating the bar of the D-ring so that the D-ring may rotate about the axis of the bar through an angle of nearly 360 degrees, and the key-holding ring may ride along the inside portion of the U-shaped portion of the D-ring about an axis perpendicular to the axis of the bar and perpendicular to the band for substantially 180 degrees. The clamp width may be substantially the same as the width of the band. The key-holding ring may be a spiral ring of material having a cross-sectional span with ends and the bar formed with a gap, such as 11E, intermediate the ends of width about that of the span to allow the key-holding ring to pass through the gap into the D-ring during assembly.

A method of making the key ring includes passing the key-holding ring through the gap into the D-ring, and passing the band through the D-ring. Pages 2-3.

(6) ISSUES

1. Whether the differences between the subject matter of claims 1, 2, 4, 6, 7, 9 and 11 and what is disclosed in the primary, secondary and tertiary references are such that the subject matter as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made when the references fail to suggest the desirability of combining what is there disclosed to meet the terms of these claims.

2. Whether the differences between the subject matter of claims 3, 5, 8 and 10 and what is disclosed in the primary, secondary, tertiary and quaternary references are such that the subject matter as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made when these four references fail to suggest the desirability of combining what is there disclosed to meet the terms of these claims.

(7) GROUPING OF CLAIMS

The claims of the groups do not stand or fall together.

(8) ARGUMENT

- I. THE PRIMARY, SECONDARY AND TERTIARY REFERENCES FAIL TO SUGGEST THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF CLAIMS 1, 2, 4, 6, 7, 9 AND 11.

The final action states:

Claim 1, 2, 4, 6, 7, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen 5,069,050 in view of Jung 4,903,514 and Momemers 4,523,443. Chen teaches a flexible band member 16 having a key ring 12 attached to one end. Jung teaches a keyholder comprising an intermediate member between the member 11 and key ring 15 in the form of a D-ring having a "V" shaped portion connecting one end of the band and the key ring. The D-ring further comprises a gap portion to be attached to the band and a clip means 20/21/22 to clamp the other end of the band together. Jung fails to teach a D-ring having a "U" shaped portion 3. It would have been considered an obvious matter of design choice to one of ordinary skill in the art to provide an intermediate member between the band and key ring of Chen as taught by Jung since it well known in the keyring art to provide as many intermediate members as desired due to the ease of attaching multiple rings together, and further to substitute "U" shape for the "V" shaped D-ring of Jung since the varying shaped of rings are well known and there is no criticality afforded the U-shape. Pp. 2-3.

...

Applicant's arguments filed 7/29/02 have been fully considered but they are not persuasive. As previously discussed, and set forth above, it is maintained that the combination and totality of the teachings set forth in the applied prior art references render the instant claims obvious and rejected. The Chen '050 reference is applied against the claims as the primary reference teaching a flexible band and a keyring. It is well known in the keyholder art that multiple rings may be attached in series, as desired, to continually add more keys to the keyholder and thus, providing an intermediate member (or several) between the band and the keyring would have been considered obvious to one of ordinary skill in the art in order to accommodate more keys. The suggestion provided in Jung is that intermediate members can be added for mounting additional key rings in order to accommodate more keys. Thus, the conclusion is that given such a teaching, it would have been obvious to provide the keyholder of Chen with an intermediate member for attaching additional key rings. Furthermore, it has been long held

that modifying the shape of a structural member, absent a disclosure of criticality of such shape, would have been obvious to one of ordinary skill in the art, especially when the prior art teaches such varying shapes (as evidenced by the cited prior art). Thus, modifying the shape of the intermediate member would have been considered an obvious matter of design choice. In addition, Applicant's arguments regarding the method limitations of claim 11 are not persuasive. The assembly of the band, D-ring and keyring would have been considered inherent to the use of the device given the rejection of the structure of the device set forth above. Accordingly, claims 1-11 stand finally rejected under 35 USC 103. Pp. 3-4.

Sheldon

We set forth below binding authorities quoted in the response filed November 19, 2001, which were not mentioned in the office action dated January 28, 2002, or the final rejection dated October 17, 2002.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

As the Federal Circuit Court of Appeals said in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999):

Close adherence to this methodology is especially important of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* [*Dembiczak*]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *See B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

Nothing in the references remotely suggests the desirability of combining what is there disclosed to meet the terms of the rejected claims. Furthermore, the contention that it would have been "considered an obvious matter of design choice to one of ordinary skill in the art to provide an intermediate member between the band and keyring" of the primary reference as said to be taught by the secondary reference is a conclusion, not a proper reason for sustaining a rejection under Section 103.

no motivation to combine

In *In re Garrett*, 33 PTCJ 43 (BPA&I, September 30, 1986) the Board criticized the Examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice" as a conclusion, not a reason, in reversing the section 103 rejection.

The rejection of method claim 11 as inherent to the device assembled from three references by hindsight is improper. "In the absence of the article in the prior art we find no basis for the conclusion that the manipulative steps of assembling the nonexistent article would be obvious." *Ex parte Rubin*, 127 U.S.P.Q. 286, 287 (Bd. of Appeals 1959).

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.¹⁵ This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."¹⁶ *In re Fritsch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

hindsight

¹⁵ *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

¹⁶ *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600.

If this ground of rejection were repeated, the Examiner was respectfully requested to associate each element in each rejected claim with corresponding elements in the references, and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of the claims. The Examiner did not and can not comply with this request.

There is no suggestion in the primary, secondary and tertiary references of the desirability of combining what is disclosed in these three references to make the band a web of material having ends looped through the D-ring and joined at the ends as called for by claim 2.

Nor do any of the four references suggest the desirability of including a clamp at the ends of the web of material as called for by claim 3.

Nor do the primary, secondary and tertiary references suggest the desirability of having the web with portions that are fastened together for most of their length to define an opening accommodating the bar of the D-ring so that the D-ring may rotate about the axis of the bar through an angle of nearly 360 degrees and the key-holding ring may ride along the inside portion of the U-shaped portion of the D-ring about an axis perpendicular to the axis of the bar and perpendicular to the band for substantially 180 degrees as called for by claim 4.

Nor do the primary, secondary and tertiary references suggest the desirability of combining what is there disclosed to form the key-holding ring of a spiral ring of material having a cross-sectional span with ends and the bar formed with a gap intermediate the ends of width about that of the cross-sectional span to allow the key-holding ring to pass through the gap into the D-ring during assembly as called for by claims 6-10.

Nor do the primary, secondary and tertiary references remotely disclose or suggest the desirability of combining what is there disclosed to meet the limitations set forth in method claim 11 of passing the key-holding ring through the gap into the D-ring and passing the band through the D-ring.

II. THE PRIMARY, SECONDARY, TERTIARY AND QUATERNARY REFERENCES DO NOT SUGGEST THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF CLAIMS 3, 5, 8 AND 10.

The final action states:

Claims 3, 5, 8, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Jung and Momemers, as applied to claim 2 above, and further in view of Sheldon 4,601,185. Sheldon teaches a keyholder comprising a band 10 having a U-shaped or V-shaped D-ring at one end and a clamp 20 for the other end of the keyholder band. It would have been obvious to one of ordinary skill in the art to modify the clamp means 20/21/22 of Jung by providing a clip type clamp as taught by Sheldon as an obvious matter of design choice. P. 3.

Since claims 3, 5, 8, and 10 are dependent upon and include all the limitations of claims 1 and 2, the reasoning set forth above in support of the patentability of the parent claims over the primary, secondary and tertiary references is submitted to support the patentability of claims 3, 5, 8 and 10 so that further discussion of the quaternary reference is submitted to be unnecessary. Furthermore, the contention that the quaternary reference can be used in rejecting these claims because providing a clip type clamp as said to be taught by Sheldon is an obvious matter of design choice is a conclusion, not a reason for rejecting claims under Section 103.

In *In re Garrett*, 33 PTCJ 43 (BPA&I, September 30, 1986) the Board criticized the Examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice" as a conclusion, not a reason, in reversing the section 103 rejection.

If this ground of rejection were repeated, the Examiner was respectfully requested to associate each element in these claims with corresponding elements in the references, and quote verbatim the language in the references regarded as suggesting the desirability of combining

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what is there disclosed to meet the terms of these claims. The Examiner did not and can not comply with this request.

CONCLUSION

In view of the foregoing authorities and reasoning and the inability of the prior art to suggest the desirability of combining what is there disclosed to meet the terms of the claimed invention, the decision of the Examiner finally rejecting all the claims should be reversed. If the Board believes a claim may be allowed in amended form, the Board is respectfully requested to include an explicit statement that such a claim may be allowed in such amended form and direct that Appellant shall have the right to amend in conformity with such statement in the absence of new references or grounds of rejection.

The brief fee of \$160 is enclosed, together with a check in the amount of \$205 for the two-month extension of time fee. Please apply any other charges or credits to Deposit Account No. 06-1050, Order No. 08914-009001.

Respectfully submitted,

FISH & RICHARDSON P.C.

APR 28 2003

Date: _____



Charles Hieken
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Enclosures: FIGS. 3-5

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1. A key ring comprising
a key-holding ring,
a band,
a D-ring coupling said band to said key-holding ring,
said D-ring having a U-shaped portion engaging the key-holding ring and a bar
between the ends of the U-shaped portion and engaging the band.

3. A key ring in accordance with claim 2 and further comprising a clamp at the ends of said web of material.

4. A key ring in accordance with claim2 wherein the web has portions that are fastened together for most of their length to define an opening accommodating the bar of the D-ring so that the D-ring may rotate about the axis of the bar through an angle of nearly 360 degrees and the key-holding ring may ride along the inside portion of the U-shaped portion of the D-ring about an axis perpendicular to the axis of the bar and perpendicular to the band for substantially 180 degrees.

5. A key ring in accordance with claim 3 wherein the clamp width is substantially the same as the width of the band.

6. A key ring in accordance with claim 1 where said key-holding ring is a spiral ring of material having a cross-sectional span with ends and said bar is formed with a gap intermediate said ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly.

7. A key ring in accordance with claim 2 wherein said key-holding ring is a spiral ring of material having a cross-sectional span and said bar has ends and is formed with a gap intermediate said ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly.

8. A key ring in accordance with claim 3 wherein said key-holding ring is a spiral ring of material having a cross-sectional span and said bar has ends and is formed with a gap

Same
claim
of registration

intermediate said ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly.

9. A key ring in accordance with claim 4 wherein said key-holding ring is a spiral ring of material having a cross-sectional span and said bar has ends and is formed with a gap intermediate said ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly.

10. A key ring in accordance with claim 5 wherein said key-holding ring is a spiral ring of material having a cross-sectional span and said bar has ends and is formed with a gap intermediate said ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly.

11. A method of making a key ring that includes a key-holding ring that is a spiral ring of material having a cross-sectional span, a band, a D-ring coupling said band to said key-holding ring and having a U-shaped portion engaging the key-holding ring and a bar having bar ends between the ends of the U-shaped portion formed with a gap intermediate said bar ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly, comprising,

passing the key-holding ring through the gap into the D-ring,
and passing the band through the D-ring.

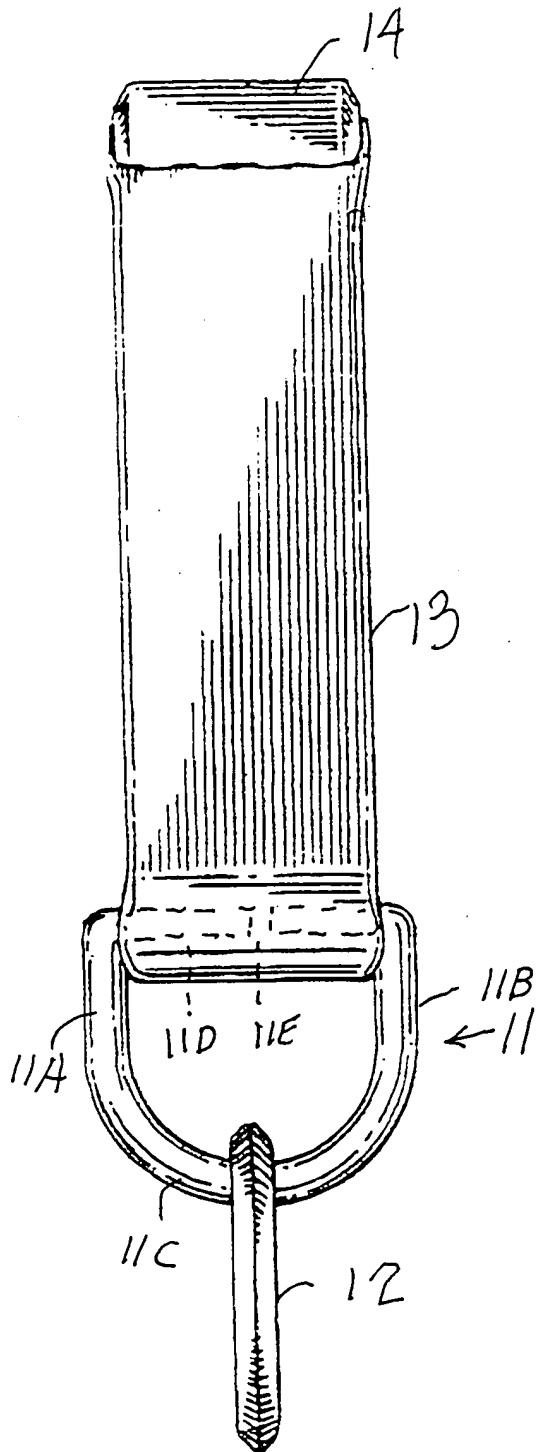


FIG. 3

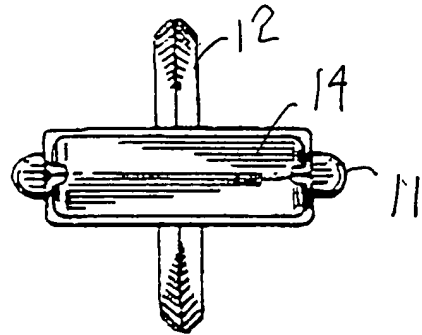


FIG. 4

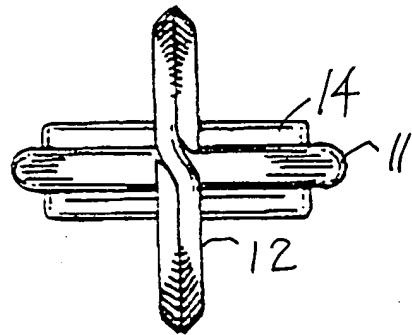


FIG. 5